

U.S. Patent Application Serial No. 10/627,348
Reply to Office Action of January 23, 2007

Amendments to the Drawings:

Two sheets of replacement formal drawings are enclosed herewith that include the proper reference numbers and labeling.

REMARKS

Applicant has read and considered the Office Action dated January 23, 2007 and the references cited therein. Claims 1-2, 4-6, 8-10, 12-14, 16-18, 20-21, and 24-27 have been amended. Claims 1-27 are currently pending. Reconsideration and reexamination are hereby requested.

The disclosure was objected to as there was an inconsistency between the use of "bar code" and "barcode" in the application. The Office Action noted that the two versions reflect the same terminology. For consistency, all occurrences of "bar code" have been changed to "barcode" throughout. In addition, it was stated that on page 5, line 61, "Fig 8" should be changed to "Fig 7" as the last figure is 7 and there is no Figure 8 specified. Applicant finds no line 61 on page 5 but believe that the Office Action was actually referring to page 14, line 26. The specification has been changed as suggested in the Office Action. Applicant asserts that the objection to the disclosure has been overcome.

The drawings were objected to as the figures and block diagrams need to have descriptive labels. New formal drawings are enclosed herewith that include the proper reference numbers and labeling. Applicant asserts that no new matter has been added. Applicant further asserts that the objection to the drawings has been overcome.

Claims 1-8 and 25 were objected to. With regard to claim 1, line 3, it was stated that "an" should be inserted between "of" and "electronic." In addition, it was stated that "a" should be inserted between "to" and "document" on line 3. Applicant has reviewed the claim language and notes that claim 3 refers to electronic document data and that "data" is plural of datum. Applicant therefore asserts that "an" should not be inserted between "of" and "electronic." Moreover, the data is directed to document processors, which is also plural. Therefore,

Applicant asserts that "a" should not be inserted between "to" and "document" as document modifies the plural processors. In addition, it was stated that in claim 25, line 1, "from" should be changed to "form." Applicant has made the change as suggested. Applicant asserts that the objections to the claims should be withdrawn.

Claims 17 and 25 were rejected under 35 U.S.C. § 101 as the claimed invention is directed to non-statutory subject matter. The Office Action indicated that an "electronic form" does not impart functionality to a computer or computing device and is considered nonfunctional descriptive material. Claim 17 has been amended and now recites that the form is stored on a computer. Moreover, claim 25 recites that the machine readable medium comprises an electronic form stored on a computer. Applicant asserts that no new matter has been added and that the claims are directed to statutory subject matter. Applicant requests that the rejection under 35 U.S.C. § 101 be withdrawn.

Claims 1-8 and 17-27 were rejected under 35 U.S.C. § 103 as being unpatentable over Xu et al., in view of Wu et al. The Office Action states that with regard to claim 1, Xu discloses a method and process for obtaining printing instances of the document including a definition of a user data input field and electronic document data, for receiving a string of characters entered in said field; including an embedded program in electronic document data, linked to the user data input field to print geometrical elements of a bar code, that represent a series of codewords derived from the characters in the string, each codeword being represented as a respective configuration of printed geometrical elements and their background in a respective area of the bar code. The Office Action contends that Xu et al. discloses all of the subject matter of the method of distributing copies except for the method of distributing copies of electronic document data to document processors and the electronic document data containing instructions for printing each instance from a respective one of the document processors. The Office action

contends that Wu et al. teaches that an electronic document could be sent by a document processor via the Internet to be modified and printed. The Office Action further contends that the printer driver is invoked and that data contained in the document are first converted to printed command that is retrieved from the printer control firmware. The Office Action contends that it would have been obvious to one of ordinary skill in the art to include the barcode when loading an electronic form as taught by Wu et al. and having it print the decoded elements of a bar code that is entered as described in the method of Xu et al. to provide more efficiency when printing a decoded bar code. Applicant respectfully traverses the rejection.

Although the Office Action contends that Xu et al. discloses an embedded program, careful review of Figure 1 and paragraph 25 as well as elsewhere in the specification, reveals that Xu only teaches an embedded graphic. In particular, Xu generates documents with bar codes. However, Xu teaches manual input of data that may be encoded in the bar codes. Xu fails to teach or suggest, including an embedded program, an electronic document for this purpose. Claim 1 recites that the embedded program is embedded in the electronic document linked to a user data input field for generating commands to print geometrical document elements. Moreover, Xu fails to teach or suggest a user data input field and electronic document for entering the data and the bar code. With the Xu system, the inputs for the data are separate from the document. Xu does not teach or suggest distribution of documents with the data input field and an embedded program.

The present invention provides advantages for manipulation and generation of geometrical elements that are not possible with the Xu reference or any other prior art or combination thereof. The present invention provides for automatically generating barcodes that is not possible with the manual input required of Xu.

Moreover, Wu fails to remedy the shortcomings of Xu. Although Wu teaches printing of electronic documents with security information, this is included only in a watermark, barcode or printed text. Wu contains no teaching or suggestion of a program embedded in the electronic document that is utilized to generate commands. Wu also fails to teach or suggest linking embedded software to a user input field in an electronic document. As neither of the cited documents or their combination teach or suggest all of the recited elements, Applicant asserts that a *prima facie* case of obviousness has not been established. Therefore, Applicant asserts that the rejection under 35 U.S.C. § 103(a) should be withdrawn. Applicant asserts that the claims patentably distinguish over the cited prior art or any prior art or combination thereof.

A speedy and favorable action in the form of a Notice of Allowance is hereby solicited. If the Examiner feels that a telephone interview may be helpful in this matter, please contact Applicant's representative at (612) 336-4728.



Respectfully submitted,

MERCHANT & GOULD P.C.

Dated: _____

6/25/07

By: _____

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